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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/238,859 01/28/99 SIMON

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MM92/0503

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EXAMINER

VERBITSKY, G

ART UNIT

PAPER NUMBER

2859

DATE MAILED:

05/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/238,859

Applicant(s)

Simony
Rethenstein et al.

Examiner

Gall Verbitsky

Group Art Unit
2859



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-8 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Objections

2. Claims 1-2 are objected to because of the following informalities: --(acousto-optic tunable filter)-- should be inserted after AOTF in line 1 of claims 1 and 2. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Prior Art in view of Kemeny et al. [hereinafter Kemeny].

The Prior Art, as stated by applicant, (spec., page 1) discloses a laser scanning microscope with an AOTF. The Prior Art discloses the problem related to the use of AOTF and, in a broad sense, suggests to measure the temperature of the AOTF.

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Kemeny discloses in Figs. 6-8 a device to control an AOTF 102 comprising an AOTF 102, a heater 164, temperature sensors (gauge) 167, 170 connected to a heater controller 166 and located within vicinity of the AOTF. The heater is capable of maintaining the temperature of the AOTF within 1°C of the desired temperature which can be between 35°- 40°C. Output lines 190a and 190b are carrying a signal from the temperature sensors to a controller (driving unit) 300. Cooling of the AOTF is achieved simply by shutting the heater off (entire col. 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the AOTF disclosed by the Prior Art with the AOTF having temperature sensors, a heater, etc., as taught by Kemeny, in order to be able to control the temperature of the device and keep it constant, as already suggested by Kemeny and very well known in the prior art.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices.
7. Any inquiry concerning this documentation should be directed to the Examiner Verbitsky whose telephone number is (703) 306-5473.

Any inquiry of general nature or related to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956.

GKV

April 07, 2000


G. BRADLEY BENNETT
PRIMARY EXAMINER
AU 2859